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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,895	02/28/2002	Phillip King Parell	581	8202

27777 7590 04/23/2004

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EXAMINER

HONG, JOHN C

ART UNIT PAPER NUMBER

3726

DATE MAILED: 04/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/084,895

**Applicant(s)**

PARELL ET AL.

**Examiner**

John C. Hong

**Art Unit**

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 12,13 and 26-31 is/are allowed.
- 6) ☐ Claim(s) 1-11,14-19,21-25,32 and 33 is/are rejected.
- 7) ☐ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Paper No. 3, Information disclosure Statement is missing Form 1449.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11,22-25,32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) Claim 1, lines 5 and 6, "the lens mold half" lacks antecedent basis.

(2) Claim 5 is double and second Claim 5 is depending on itself.

(3) Claim 22, line 2, "said lens mold half" lacks antecedent basis.

(4) Claim 23 is depending on itself.

(5) Claim 32, line 5, "said lens mold" lacks antecedent basis.

(6) Claim 32, lines 5 and 6, "said lens top" lacks antecedent basis.

(7) Claim 33, line 2,"said lens mold half" lacks antecedent basis.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,4,5, 9, 11,14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoy et al. (U.S. Patent 4,173,606).

Art Unit: 3726

Stoy et al. disclose : Regarding Claims 1,4,5,9 and 11, a tip comprising : a substantially rigid body portion (16) having a distal end and a proximal end, the distal end having an outer surface that is complementary to the shape of a lens mold half to be transferred, the body portion having sealing means (19) peripheral to the outer surface for engagement with the lens mold; and at least one aperture(17) extending through the body portion from said distal end to the proximal end (Fig. 4; col. 10, lines 40-48); Regarding Claims 14 and 15, a tip comprising: a substantially rigid polymeric body portion having a distal end and a proximal end, the distal end having a concave outer surface complementary to the convex surface of the Front Curve lens mold, the body portion having an annular sealing ring peripheral to the concave outer surface for engagement with the annular flange; and at least one aperture extending through the body portion from the distal end to said proximal end(Fig. 4; col. 10, lines 40-48) .

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham, 2 USPQ 2d 1647 (1987)*.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3726

6. Claims 16-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoy et al. (U.S. Patent 4,173,606).

Stoy et al. teach a system comprising: assembly having a tip having a substantially rigid body, the body portion having a distal end and a proximal end, the distal end having an outer surface that is complementary to the shape of the lens mold half to be handled, the body portion having sealing means peripheral to the outer surface for engagement with the lens mold handling means, the tip having at least one aperture extending through the body portion from the distal end to said proximal end (Fig. 4; col. 10, lines 40-48).

Stoy et al. fail to teach a robotic assembly having a transport tip and a source of pressure differential in flow communication with the at least one aperture.

But it is well known in the art utilizing a robotic assembly having a transport tip and a source of pressure differential in flow communication with the at least one aperture, and it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilizing a robotic assembly having a transport tip and a source of pressure differential in flow communication with the at least one aperture to the tip of Stoy et al. so as to effective manufacturing of the ophthalmic lens.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham, 2 USPQ 2d 1647 (1987)*.

*Allowable Subject Matter*

7. Claims 12,13,26-31 are allowed.
8. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John C. Hong whose telephone number is 703-305-0779. The examiner can normally be reached on M-F(07:00-16:30)First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1784. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John C. Hong  
Primary Examiner  
Art Unit 3726

jh  
April 19, 2004